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Edward Langer Date July 3 '05
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of : Redler, Yeshayahu
Serial No. : 09/786,364
Filed : March 15, 2001
For : SECURE DATA ENTRY PERIPHERAL DEVICE

JUL 08 2005

Group Art Unit 2134
Examiner: SIMITOSKI, Michael J.

Tel Aviv, Israel
July 3, 2005

Hon. Commissioner of Patents and Trademarks
Alexandria, VA

Sir:

PETITION TO WITHDRAW FINAL REJECTION AS PREMATURE

PETITION UNDER 37 CFR SEC 1.181

Applicant hereby petitions to withdraw the Final Rejection status of the Office Action mailed April 5, 2005 as premature.

Applicant believes that the Final Rejection was mailed:
1) before the development of an issue, and
2) the Final Rejection contains a technical inaccuracy which reflects a misunderstanding on the part of the Examiner, resulting in a "hasty" and inconsistent prosecution record.

To support this position, Applicant presents his supporting arguments.

TIMING OF THIS PETITION

The present petition is being submitted after the June 1, 2005 telephone interview, conducted after receipt of the Final Rejection Office Action. The Final Rejection was mailed on April 5, 2005.

It is believed that in these circumstances, that this petition is timely, as the case is still pending per MPEP Sec. 706.07(d), and the telephone Interview summary generated on January 1, 2005 indicates that the Examiner is not inclined to accept any post

final rejection amendment, since he believes that a new search is required.

SUMMARY OF PROSECUTION HISTORY

The subject application was filed on March 15, 2001 as a NS of a PCT application having an international filing date of September 16, 1999.

The first Office Action was mailed after a long delay of 3 and a half years, on September 21, 2004.

A response to the first Office Action was filed on December 21, 2004.

A Final Rejection Office Action was mailed on April 5, 2005 rejecting all of the claims.

In a post-final telephone interview with the Examiner, conducted by telephone on 31 May 2005, a proposed amendment was suggested to the independent claims relating to a public key algorithm.

In the Interview Summary mailed June 1, 2005, the Examiner indicated that if this amendment were submitted in an after-final amendment, an Advisory Action would be mailed indicating a need for further search and consideration.

The above summarizes the status of the prosecution thus far.

FINAL REJECTION SENT PRIOR TO DEVELOPMENT OF AN ISSUE - PLACES UNFAIR EXTRA BURDEN ON APPLICANT

In the discussion with the Examiner during the post-final telephone interview, the issue of a "secure keyboard device in a computer system adapted for Internet communication" was identified as the key to patentability, as the Examiner admitted that Clark ('569) does not disclose an environment related to Internet communication.

More specifically, the invention relates to a public key algorithm, and Clark does not.

Therefore, the Examiner's statement that an after final amendment on this point will require a further search is not acceptable.

The reason for this is that with respect to the present invention, there is a long prosecution history, including prior art references cited and arguments made, which placed the matter of an Internet communication context as a major, primary theme.

As proof of this, in the PCT prosecution of International Application PCT/IL 99/00504, a Written Opinion of the IPEA/US was mailed on October 2, 2000. After an interview with Examiner Rita Ziemer by the undersigned on November 21, 2000, it was indicated in the Interview Summary that the cited prior art could be overcome by an amendment.

Although the Clark ('569) reference used in the final rejection was not cited in the PCT prosecution, Applicant responded to the Written Opinion in a letter dated November 29, 2000 (a copy of which is attached here) by clearly stating that the invention was related to Internet E-commerce (see page 2, first line).

The context of the invention was originally framed in relation to the rise of the Internet data highway, which has dramatically increased the need for secure data transmission, per the background in the specification at page 1, 1st paragraph, lines 1 to 9.

From the above it is clear that the surrounding technology of the inventive method and device was always secure data transmission related to Internet communication. Not only was this stated in the original specification, but also, as part of the PCT examination process, conducted by USPTO Examiners, it was argued and highlighted by the Applicant that the invention was related to Internet communication.

Therefore, the Examiner's statement in the Interview Summary that he will require a new search is not acceptable.

Applicant believes that the Examiner should have taken the proper search context into account with his initial search.

TECHNICAL INACCURACY OF THE FINAL REJECTION

As understood by the Applicant's attorney, if there is a technical inaccuracy in the Final Rejection, this can be considered as a basis for the present petition to withdraw the Final Rejection and re-open the prosecution.

It is believed that the Examiner has misunderstood the technical basis of the invention, which is to provide encryption and decryption techniques strong enough to meet the requirements of a secure Internet communication format.

The system described by the Clark patent ('569) largely relates to typical transactions within closed systems, e.g. ATM, banks, lottery, that employ encryption methods, such as a PIN code, as described in the background, per col. 1, lines 39-48. This is additionally stated in the description, at col. 2, lines 30-36 and at col. 8, lines 19-29.

However, encryption methods, such as a PIN code, may only provide a low security level within closed systems. Therefore, the encryption methods to which Clark relates are completely inadequate for encoding and decoding data information in a secure Internet communication format known today.

The technical inaccuracy of the final rejection is that it places encryption methods, such as the PIN code of Clark ('569), at the same security level as the public key algorithm disclosed in the present invention.

It is Applicant's position that the Examiner's statement in the telephone interview indicates a technical inaccuracy, since the Internet context, which is in common-use today, requires strong encryption and decryption techniques.

Therefore, it is concluded that the Examiner's statement that there is a need for a new search is unacceptable.

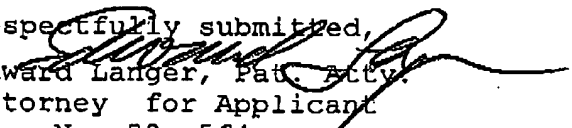
It should have been clear from the outset, in view of the PCT prosecution history, which was available to the Examiner, that the initial search should have been conducted in relation to the Internet context.

It is believed that the technical inaccuracy of the current Final Rejection is established, since the Internet context requires stronger encryption and decryption techniques. The Examiner should have understood this as a technical distinction as he began organizing his searching efforts.

Therefore, it remains Applicant's position that the finality of the last Office Action was premature, and the status of the application should be changed so that it is not in the post-final rejection condition.

Therefore, it is respectfully requested that the present petition be reviewed promptly and that the Applicant be notified of any questions requiring an immediate response, with a view toward resolving the status of this case immediately.

Respectfully submitted,


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